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| 09/981,392 | 10/17/2001 | Shell S. Simpson | 10007682-1 | 7709 |

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| EXAMINER | |
|---|---|
| BATURAY, ALICIA | |

| ART UNIT | PAPER NUMBER |
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| 2155 | |

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/981,392 | SIMPSON, SHELL S. | |
| | Examiner | Art Unit | |
| | Alicia Baturay | 2155 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *13 April 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-46* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *17 October 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *10172001*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

1. This Office Action is in response to the amendment filed 13 April 2005.

2. Claim 38 was amended.

3. Claims 1-46 are pending in this Office Action.

### *Response to Amendment*

4. The rejection is respectfully maintained as set forth in the last Office Action mailed on 13 January 2005. Applicant's arguments with respect to claims 1-46 have been fully considered but they are deemed to be moot and the old rejection maintained.

### *Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-5, 7, 11-13, 18-23, 25-27, 29-35, 37-42, and 46 are rejected under 35 U.S.C. 102(e) as being anticipated over Adamske et al. (U.S. 6,615,234).

7. As to claim 1, Adamske teaches a client program in a web-based environment (Adamske, Fig. 2, element 11; col. 4, lines 42-44), a method for controlling production and display of an image represented by data generated at a source service (Adamske, col. 6, lines 18-21), the

data representing at least in part a predetermined graphic symbol referencing a particular symbol set (Adamske, col. 8, lines 24-36), the method comprising the steps of: accessing the source service (Adamske, col. 8, lines 46-48); dynamically generating a printable version of the image represented by the data at the source service under interactive control of the client program, the printable version including the predetermined graphic symbol referencing the particular symbol set (Adamske, col. 8, lines 46-67); referencing the printable version of the image represented by the data from a composition stored in an imaging store (Adamske, col. 8, lines 63-67); accessing the composition from a destination service; and if the destination service contains the particular symbol set and if the destination service is instructed to produce the printable version of the represented image, then forwarding the printable version of the represented image to the destination service and then producing the represented image including the predetermined graphic symbol under interactive control by the client program (Adamske, col. 9, lines 19-28).

8. As to claim 2, Adamske teaches the invention described in claim 1, including the method where the represented image comprises a document (Adamske, col. 3, lines 27-30).

9. As to claim 3, Adamske teaches the invention described in claim 2, including the method where the document is selected from the group consisting of legal instruments, financial instruments, governmental instruments, money orders, wills, and checks (Adamske, col. 6, line 58 – col. 7, line 4).

10. As to claim 4, Adamske teaches the invention described in claim 1, including the method where the predetermined graphic symbol comprises a symbol of authentication (Adamske, col. 8, line 67 – col. 9, line 2).

11. As to claim 5, Adamske teaches the invention described in claim 4, including the method where the symbol of authentication comprises at least one signature (Adamske, col. 8, line 67 – col. 9, line 2).

12. As to claim 7, Adamske teaches the invention described in claim 1, including the method where the predetermined graphic symbol comprises a predetermined string of characters (Adamske, col. 8, lines 24-27).

13. As to claim 11, Adamske teaches the invention described in claim 1, including the method where the printable version of the represented image does not exist prior to the dynamically generating at the source service under interactive control of the client program (Adamske, col. 5, lines 15-24).

14. As to claim 12, Adamske teaches the invention described in claim 1, including the method where a web content acting on behalf of an accessed destination service generates a display at the client program comprising controls that include user selectable production options and a preview version of the represented image based upon the user selected options

and upon the capabilities of a production device represented by the accessed destination service (Adamske, Fig. 3; col. 5, lines 6-14).

15. As to claim 13, Adamske teaches the invention described in claim 12, including the method where the production device comprises a print destination, where the web content is an executable content acting on behalf of the accessed destination service representing the print destination, and where the preview version of the represented image sequentially changes dynamically, based upon the capabilities of print destinations sequentially accessed through multiple destination services, prior to forwarding the printable version of the represented image to a destination service (Adamske, col. 3, line 64 – col. 4, line 8).

16. As to claim 18, Adamske teaches the invention described in claim 12, including the method where the preview version of the image is retrieved by the accessed destination service from the imaging store (Adamske, col. 8, lines 63-67).

17. As to claim 19, Adamske teaches the invention described in claim 12, including the method where the client program accesses the destination service using an access technique selected from the group consisting of redirection by a second executable content and directly addressing the destination service via a Uniform Resource Locator (URL) (Adamske, col. 8, lines 54-63).

18. As to claim 20, Adamske teaches the invention described in claim 19, including the method where the client program accesses the imaging store via the second executable content (Adamske, col. 6, lines 10-15).

19. As to claim 21, Adamske teaches the invention described in claim 1, including the method where the printable version of the represented image is stored in a graphic store associated with the imaging store and managed indirectly from the client program (Adamske, col. 6, lines 10-15).

20. As to claim 22, Adamske teaches the invention described in claim 1, including the method where the imaging store is associated with a user's identity (Adamske, col. 8, lines 29-45).

21. As to claim 23, Adamske teaches the invention described in claim 22, including the method where the user's identity is accessed by an executable content acting on behalf of the destination service (Adamske, col. 8, lines 54-67).

22. As to claim 25, Adamske teaches a system for controlling printing and display of an image in a distributed computing environment, comprising: a first computer (Adamske, Fig. 2, element 11; col. 4, lines 42-44); a second computer accessible from the first computer and operable to provide a first executable content to the first computer in response to a request from the first computer (Adamske, Fig. 2, element 22; col. 4, lines 51-53); the second

computer further operable to dynamically generate and display a printable version of data representing the image under the interactive control of the first computer via the first executable content, the represented image comprising at least in part a predetermined graphic symbol referencing a particular symbol set (Adamske, col. 8, lines 46-67); an imaging store accessible from the second computer and operable to access and store a composition referencing the printable version of the data (Adamske, Fig. 2, element 26; col. 6, lines 10-12); and at least one destination computer accessible from the first computer and operable to access the composition, the destination computer representing a production device, such that, if the at least one the destination computer contains the particular symbol set, then the production device represented by the at least one the destination computer is operable to produce the represented image including printing the predetermined graphic symbol under interactive control of the first computer (Adamske, col. 9, lines 19-28).

23. As to claim 26, Adamske teaches the invention described in claim 25, including the method where the represented image comprises a document (Adamske, col. 3, lines 27-30).

24. As to claim 27, Adamske teaches the invention described in claim 26, including the method where the document is selected from the group consisting of legal instruments, financial instruments, governmental instruments, money orders, wills, and checks (Adamske, col. 6, line 58 – col. 7, line 4).

25. As to claim 29, Adamske teaches the invention described in claim 25, including the system where the second computer comprises the first computer (Adamske, col. 4, lines 44-52).

26. As to claim 30, Adamske teaches the invention described in claim 25, including the system where the second computer comprises the destination computer (Adamske, col. 4, lines 44-52).

27. As to claim 31, Adamske teaches the invention described in claim 25, including the system where the first computer comprises the destination computer (Adamske, col. 3, line 61 – col. 4, line 8).

28. As to claim 32, Adamske teaches the invention described in claim 25, including the system where the imaging store is associated with a graphic store configured to receive and store the printable version of the data, the first computer operable to manage indirectly the imaging store and the graphic store (Adamske, col. 8, lines 46-67).

29. As to claim 33, Adamske teaches the invention described in claim 25, including the system where the at least one the destination computer is operable to access the printable version of the data in the imaging store (Adamske, col. 6, lines 3-15).

30. As to claim 34, Adamske teaches the invention described in claim 33, including the method where the imaging store is associated with a user's identity (Adamske, col. 8, lines 29-45).

31. As to claim 35, Adamske teaches the invention described in claim 34, including the system where the at least one destination computer is operable to access the user's identity using a process selected from the group consisting of directly accessing and accessing via executable content running in the first computer (Adamske, col. 8, lines 46-67).

32. As to claim 37, Adamske teaches the invention described in claim 33, including the method where the production device comprises a print destination, where the web content is an executable content acting on behalf of the accessed destination service representing the print destination, and where the preview version of the represented image sequentially changes dynamically, based upon the capabilities of print destinations sequentially accessed through multiple destination services, prior to forwarding the printable version of the represented image to a destination service (Adamske, col. 3, line 64 – col. 4, line 8).

33. As to claim 38, Adamske teaches in a distributed computing environment, a computer (Adamske, Fig. 2, element 11; col. 4, lines 42-44) for controlling production and display of an image represented by data generated at a source service (Adamske, col. 6, lines 18-21), the data representing at least in part a predetermined graphic symbol referencing a particular symbol set (Adamske, col. 8, lines 24-36), the computer operable to: access the source

service (Adamske, col. 8, lines 46-48); interactively direct the source service to dynamically generate a printable version of the represented image, the printable version including the predetermined graphic symbol referencing the particular symbol set (Adamske, col. 8, lines 46-67); reference the printable version of the represented image via a composition stored in an imaging store (Adamske, col. 8, lines 63-67); access a destination service; and if the destination service contains the particular symbol set, then interactively directing the destination service exclusively to access and produce the printable version of the represented image, including the predetermined graphic symbol (Adamske, col. 9, lines 19-28).

34. As to claim 39, Adamske teaches the invention described in claim 38, including the method where the represented image comprises a document (Adamske, col. 3, lines 27-30).

35. As to claim 40, Adamske teaches the invention described in claim 39, including the method where the document is selected from the group consisting of legal instruments, financial instruments, governmental instruments, money orders, wills, and checks (Adamske, col. 6, line 58 – col. 7, line 4).

36. As to claim 41, Adamske teaches the invention described in claim 38, including the method where the predetermined graphic symbol comprises a symbol of authentication (Adamske, col. 8, line 67 – col. 9, line 2).

37. As to claim 42, Adamske teaches the invention described in claim 41, including the method where the symbol of authentication comprises at least one signature (Adamske, col. 8, line 67 – col. 9, line 2).

38. As to claim 46, Adamske teaches the invention described in claim 38, including the method where a web content acting on behalf of an accessed destination service generates a display at the client program comprising controls that include user selectable production options and a preview version of the represented image based upon the user selected options and upon the capabilities of a production device represented by the accessed destination service (Adamske, Fig. 3; col. 5, lines 6-14).

***Claim Rejections - 35 USC § 103***

39. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

40. Claims 6, 8, 14-16, 24, 28, and 43 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Adamske and further in view of Powers (U.S. 6,438,584).

Adamske teaches the invention described as claimed including delivering an electronic document over a network and printing in hard copy form at a remote destination. The system

described also includes a collaborative signature feature that allows each signatory to sign the document electronically (see Adamske, "Summary of the Invention").

41. As to claim 6, Adamske teaches the invention described in claim 1, including a symbol set (Adamske, col. 8, lines 24-36)

Adamske does not explicitly teach the symbol set as a font.

However, Powers teaches the method where the particular symbol set is a font (Powers, col. 8, lines 8-9).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Adamske in view of Powers in order to have the symbol include a font. One would be motivated to do so in order to provide routing and delivery of electronic communications.

42. As to claim 8, Adamske teaches the invention described in claim 7, including the method where the predetermined graphic symbol comprises a predetermined string of characters (Adamske, col. 8, lines 24-27).

Adamske does not explicitly teach the predetermined string of characters comprising of identification numbers, sequence numbers, dates, graphic coordinates, geographic coordinates, and codes.

However, Powers teaches the method where the predetermined string of characters comprises a string of alphanumeric characters selected from the group consisting of

identification numbers, sequence numbers, dates, graphic coordinates, geographic coordinates, and codes (Powers, col. 8, lines 32-34).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Adamske in view of Powers in order to have the predetermined string of characters include identification numbers, sequence numbers, dates, graphic coordinates, geographic coordinates, and codes. One would be motivated to do so in order to provide routing and delivery of electronic communications.

43. As to claim 14, Adamske teaches the invention described in claim 12, the preview version of the represented image sequentially changes dynamically (Adamske, col. 3, line 64 – col. 4, line 8).

Adamske does not explicitly teach the preview version changing as the user makes changes to it.

However, Powers teaches the method where the preview version changes dynamically, dependent on interactive user control settings at the client program (Powers, col. 10, lines 14-32).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Adamske in view of Powers in order to allow the preview version to change as the user makes changes to it. One would be motivated to do so in order to provide routing and delivery of electronic communications.

44. As to claim 15, Adamske teaches the invention described in claim 12, including a predetermined graphic symbol referencing a particular symbol set (Adamske, col. 8, lines 24-36).

Adamske does not explicitly teach the predetermined graphic symbol being displayed only when the client program accesses a service that contains the symbol set.

However, Powers teaches the method where the predetermined graphic symbol is displayed only when the client program accesses a destination service that contains the particular symbol set (Powers, col. 7, lines 32-40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Adamske in view of Powers in order to restrict the access to the predetermined graphic symbol, allowing it only to be displayed when the client program accesses a service that contains the symbol set. One would be motivated to do so in order to provide routing and delivery of electronic communications.

45. As to claim 16, Adamske teaches the invention described in claim 12, including a predetermined graphic symbol referencing a particular symbol set (Adamske, col. 8, lines 24-36).

Adamske does not explicitly teach not displaying the predetermined symbol.

However, Powers teaches the method where the predetermined graphic symbol is not displayed (Powers, col. 10, lines 18-26).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Adamske in view of Powers in order to not display the predetermined

symbol. One would be motivated to do so in order to provide routing and delivery of electronic communications.

46. As to claim 24, Adamske teaches the invention described in claim 22, including where the imaging store is associated with a user's identity (Adamske, col. 8, lines 29-45).

Adamske does not explicitly teach the user's identity being accessed directly by the destination service.

However, Powers teaches the method where the user's identity is accessed directly by the destination service (Power, col. 6, lines 19-21).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Adamske in view of Power in order to enable the user's identity to be accessed directly by the destination service. One would be motivated to do so in order to provide routing and delivery of electronic communications.

47. As to claim 28, Adamske teaches the invention described in claim 25, including the system where the predetermined graphic symbol comprises at least one signature (Adamske, col. 8, line 67 – col. 9, line 2).

Adamske does not explicitly teach the symbol set as a font.

However, Powers teaches the method where the particular symbol set is a font (Powers, col. 8, lines 8-9).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Adamske in view of Powers in order to have the symbol include a font.

One would be motivated to do so in order to provide routing and delivery of electronic communications.

48. As to claim 43, Adamske teaches the invention described in claim 34, including a symbol set (Adamske, col. 8, lines 24-36)

Adamske does not explicitly teach the symbol set as a font.

However, Powers teaches the method where the particular symbol set is a font (Powers, col. 8, lines 8-9).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Adamske in view of Powers in order to have the symbol include a font. One would be motivated to do so in order to provide routing and delivery of electronic communications.

49. Claims 9, 10, 17, 36, 44, and 45 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Adamske in view of Powers and further in view of Shima (U.S. 6,369,909).

50. As to claim 9, the combination of Adamske and Powers teaches the invention described in claim 1, including where the predetermined graphic symbol is not displayed (Powers, col. 10, lines 18-26).

The combination of Adamske and Powers does not explicitly teach printing the document without the predetermined graphic.

However, Shima teaches where, if the destination service does not contain the particular symbol set and if the destination service is instructed to produce the printable version of the represented image, then producing the represented image excluding the predetermined graphic symbol (Shima, col. 10, lines 40-46).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Adamske and Powers in view of Shima in order enable printing of the document without the predetermined graphic. One would be motivated to do so in order to provide an environment capable of receiving and printing a composite document containing a plurality of resources of various file formats.

51. As to claim 10, the combination of Adamske and Powers teaches the invention described in claim 9, including where the predetermined graphic symbol is not displayed (Powers, col. 10, lines 18-26).

The combination of Adamske and Powers does not explicitly teach the use of a substitute graphic.

However, Shima teaches the method where, if the destination service does not contain the particular symbol set and if the destination service is instructed to produce the printable version of the represented image, then producing a substitute graphic symbol in place of the predetermined graphic symbol by using a substitute symbol set (Shima, col. 10, lines 40-46).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Adamske and Powers in view of Shima in order to enable the use of a substitute graphic. One would be motivated to do so in order to provide an environment capable of receiving and printing a composite document containing a plurality of resources of various file formats.

52. With respect to claim 17, the combination of Adamske and Powers teaches the invention described in claim 16, including the method where the predetermined graphic symbol is not displayed (Powers, col. 10, lines 18-26).

The combination of Adamske and Powers does not explicitly teach the use of a proxy graphic.

However, Shima teaches the method where, if the client program accesses a destination service that contains the particular symbol set, a proxy graphic symbol is displayed in place of the predetermined graphic symbol, the proxy graphic symbol when displayed providing affirmation that the particular symbol set is contained in the destination service (Shima, col. 10, lines 40-46).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Adamske and Powers in view of Shima in order to enable the use of a proxy graphic. One would be motivated to do so in order to provide an environment capable of receiving and printing a composite document containing a plurality of resources of various file formats.

53. As to claim 36, the combination of Adamske and Powers teaches the invention described in claim 25, including where the predetermined graphic symbol is not displayed (Powers, col. 10, lines 18-26).

The combination of Adamske and Powers does not explicitly teach printing the document without the predetermined graphic.

However, Shima teaches where, if the destination service does not contain the particular symbol set and if the destination service is instructed to produce the printable version of the represented image, then producing the represented image excluding the predetermined graphic symbol (Shima, col. 10, lines 40-46).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Adamske and Powers in view of Shima in order enable printing of the document without the predetermined graphic. One would be motivated to do so in order to provide an environment capable of receiving and printing a composite document containing a plurality of resources of various file formats.

54. As to claim 44, the combination of Adamske and Powers teaches the invention described in claim 38, including where the predetermined graphic symbol is not displayed (Powers, col. 10, lines 18-26).

The combination of Adamske and Powers does not explicitly teach printing the document without the predetermined graphic.

However, Shima teaches where, if the destination service does not contain the particular symbol set and if the destination service is instructed to produce the printable version of the

represented image, then producing the represented image excluding the predetermined graphic symbol (Shima, col. 10, lines 40-46).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Adamske and Powers in view of Shima in order enable printing of the document without the predetermined graphic. One would be motivated to do so in order to provide an environment capable of receiving and printing a composite document containing a plurality of resources of various file formats.

55. As to claim 45, the combination of Adamske and Powers teaches the invention described in claim 44, including where the predetermined graphic symbol is not displayed (Powers, col. 10, lines 18-26).

The combination of Adamske and Powers does not explicitly teach the use of a substitute graphic.

However, Shima teaches the method where, if the destination service does not contain the particular symbol set and if the destination service is instructed to produce the printable version of the represented image, then producing a substitute graphic symbol in place of the predetermined graphic symbol by using a substitute symbol set (Shima, col. 10, lines 40-46).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Adamske and Powers in view of Shima in order to enable the use of a substitute graphic. One would be motivated to do so in order to provide an environment capable of receiving and printing a composite document containing a plurality of resources of various file formats.

***Response to Arguments***

56. Applicant's arguments filed 13 January 2005 have been fully considered, but they are not persuasive for the reasons set forth below.

57. ***Applicant Argues:*** As to claims 1, 25, and 38, Applicant states "Claim 1 recites a method for controlling production and display of an image and 'dynamically generating a printable version of said image...said printable version including said predetermined graphic symbol referencing said particular symbol set' and 'if said destination service contains said particular symbol set and if said destination service is instructed to produce said printable version of said represented image, then forwarding said printable version of said represented image to said destination service'. Adamske does not teach these limitations...Neither the destination printer 40 nor the remote print spooler server 30 of Adamske are taught as containing a particular symbol set or being checked for a particular symbol set."

***In Response:*** The examiner respectfully submits that Adamske teaches a web server that updates the document at the print preview stage (dynamically generating a printable version of the image) as signatories add their signatures, which are housed in a signature database, to the document (the printable version including the predetermined graphic symbol referencing the particular symbol set).

Adamske also teaches the web server accessing a signature database if the signatories do have electronic signatures (if said destination service contains said particular symbol set – see Adamske, col. 8, lines 46-67), and sending the document to the destination printer for

printing of a hardcopy (and if said destination service is instructed to produce said printable version of said represented image, then forwarding said printable version of said represented image to said destination service – see Adamske, col. 9, lines 19-28).

In Applicant's specification, it is disclosed that "a production device 154 such as a conventional printer is incapable of self-representation and consequently must be connected to and controlled by an external destination service 34 running on an intermediate device such as a desktop computer or a print server machine." (See specification, page 12, lines 24-27). The claims state that if the destination service is able produce a particular symbol set (the web server that holds the document with the required signatures that were accessed via the signature database – see Adamske, col. 9, lines 19-28 and col. 8, lines 24-36), then this document is forwarded to that service.

58. ***Applicant Argues:*** Applicant states "The motivation provided [to combine Adamske and Powers] by the Examiner is improper because it is not shown that the combination is desirable."

***In Response:*** The examiner respectfully submits that in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.

1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Adamske and Powers teach routing and delivery of electronic documents using a network (see Adamske, Abstract and Powers, col. 5, lines 59-63). The teachings of both references are analogous, and therefore it would have been obvious to combine them. One would be motivated to do so in order to provide routing and delivery of electronic communications (Powers, col. 5, lines 59-63).

59. ***Applicant Argues:*** Applicant states "The motivation provided [to combine Adamske, Powers, and Shima] by the Examiner is improper because it is not shown that the combination is desirable."

***In Response:*** The examiner thanks the Applicant for pointing out the mistake in the in the motivation for the rejection of claims 9, 10, 17, 36, 44, and 45; it was in fact meant to assert that the aforementioned claims were unpatentable over the combination of Adamske and Powers and in further view of Shima. The examiner respectfully submits that in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Adamske (see Adamske, Abstract), Powers (Powers, col. 5, lines 59-63), and Shima

(Shima, col. 3, lines 18-22) teach routing and delivery of electronic documents using a network. The teachings of both references are analogous, and therefore it would have been obvious to combine them. One would be motivated to do so in order to provide an environment capable of receiving and printing a composite document containing a plurality of resources of various file formats (Shima, col. 3, lines 18-22).

*Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Baturay whose telephone number is (571) 272-3981. The examiner can normally be reached at 7:30am - 5pm, Monday - Thursday, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alicia Baturay
July 7, 2005

SALEH NAJJAR
PRIMARY EXAMINER